

***United States Court of Appeals
for the Second Circuit***



**BRIEF FOR
APPELLEE**

No. 76-7041

(To be argued by Mr. Robert B. Russell)

United States Court of Appeals For the Second Circuit

GEORGE LERNER, JULIUS ELLMAN,
PLAINTIFFS-APPELLANTS,

v.

**CHILD GUIDANCE PRODUCTS, INC., and
QUESTOR CORPORATION,**
DEFENDANTS-APPELLEES.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

ANSWERING BRIEF OF DEFENDANTS-APPELLEES

ROBERT B. RUSSELL
RUSSELL & NORTON
One Boston Place
Boston, Massachusetts 02108
(617) 227-3835

*Attorneys for the
Defendants-Appellees*

Of Counsel:

ELIAS MESSING, Esq.
HAYS, ST. JOHN, ABRAMSON & HEILBRON
120 Broadway
New York, New York 10005

TABLE OF CONTENTS

	Page
I. Counter-Statement of Questions Presented	1
II. Introduction	2
III. Defendants-Appellees' simple and direct statement of basis for affirming the decision of the District Court	2
IV. Defendants-Appellees' detailed reply to Plaintiffs-Appellants' Brief	4
(1) The Invention	4
(2) Plaintiffs-Appellees' reliance on commercial success is misplaced	5
(3) The Jury's finding of non-obviousness of the accused devices	6
(4) Plaintiffs' contention that the Court reversed the proper order is not well taken	6
(5) Plaintiffs' request for a narrow interpretation of the claims so as to preserve their validity fails additionally because, even if narrowly construed, they are invalid	7
(6) The level of ordinary skill in the art is easily ascertainable from reading the references	8
Conclusion	8

TABLE OF CITATIONS

Cases

<i>American Infra-Red Radiant Co., Inc. v. Lambert Industries, Inc.</i> , 360 F.2d 977, 149 USPQ 722, 723 (C.A. 8, 1966)	5
<i>Canadian-Ingersoll-Rand Co. Ltd. v. Peterson Products of San Mateo</i> , 223 F. Supp. 803, 139 USPQ 61, 64-65 (D.C. N. Calif. 1963)	5

	Page
<i>Monoplastics, Inc. v. Caldoz, Inc.</i> , 264 F. Supp. 57, 153 USPQ 328, 331 (D.C. Conn. 1966)	5, 7
<i>Mostantuono v. Ronconi</i> , 278 F. Supp. 144, 156 USPQ 629 (D.C. S.D. N.Y. 1968)	4, 7
<i>Ripple Sole Corp. v. Am. Biltrite Rubber Co., Inc.</i> , 302 F.2d 2, 133 USPQ 355 (C.A. 1, 1962)	5
<i>Sakraida v. Ag Pro, Inc.</i> , U.S. , 189 USPQ 449 (1976)	7
<i>White v. Dunbar</i> , 119 U.S. 47 (1886)	7

United States Court of Appeals For the Second Circuit

No. 76-7041

GEORGE LERNER, JULIUS ELLMAN,
PLAINTIFFS-APPELLANTS,

v.

CHILD GUIDANCE PRODUCTS, INC., and
QUESTOR CORPORATION,
DEFENDANTS-APPELLEES.

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

ANSWERING BRIEF OF DEFENDANTS-APPELLEES

I. COUNTER-STATEMENT OF QUESTIONS PRESENTED

(1) When the structure defined in a patent claim is anticipated by the prior art, except for differences which are so slight as to be found equivalent, can the claim be valid?

(2) When the only difference between a claimed structure and the prior art is that the claim defines a single part performing the same function as a plurality of parts in the prior art, can the claim be valid?

(3) Can validity be properly predicated upon the mere miniaturization of a prior art device?

II. INTRODUCTION

Plaintiffs-Appellants have raised numerous points in their brief each of which, we submit, fails for one reason or another as we will explain more in detail below. There is, however, a simpler and more direct way to view this appeal which leads quickly and inexorably to a conclusion that the decision below must be affirmed. In this brief, therefore, we will start with an explanation of the simple and direct approach, on the expectation that such will end the matter. Should the Court, however, wish to proceed further with a more detailed analysis of plaintiffs-appellants various points, we also provide herein defendants-appellees further specific answer to them.

II. DEFENDANTS-APPELLEES' SIMPLE AND DIRECT STATEMENT OF BASIS FOR AFFIRMING THE DECISION OF THE DISTRICT COURT

As appellants note at page 19 and 24 of their brief, the rights of a patentee "depend upon the claim in his patent", and before one can assess the validity of a patent the "differences between the prior art and the claims at issue are to be ascertained".

In the case at bar it was stipulated that the issue of validity would stand or fall on claim 1 and in ascertaining the differences between the prior art and the claims in issue, the Trial Court made the following findings of fact:

"Bienengraber literally anticipates every element and feature of the structure described in the claims, except for their recitation that the tone bars are sup-

ported on the keys and that the movement of the keys is limited by a key support ledge extending across the front of the piano. But these were two of the very limitations which the jury had to disregard in order to find the patent infringed."

Such findings, of course, will not normally be disturbed unless "clearly erroneous". Here, they are well supported by the record. This is apparent from a simple reading of claim 1 of the patent (Vol. I, page 32) against Bienengraber (Vol. I, page 327). In fact, although plaintiffs-appellants object to the conclusions reached by the Court below, they do not contest the *factual accuracy* of these findings.

This resolves the validity issue into a virtual cipher. The only two differences, i.e., (a) mounting the tone bar on an elongated extension of the key instead of on a linkage, and (b) limiting the motion of the keys by having them strike a ledge which extends across the front of the piano instead of striking little stops located under the keys, as in Bienengraber, which differences plaintiffs-appellants contend encompass an invention—were found by the jury to be so nearly equal that the difference could be ignored, i.e., that the two forms "employ substantially the same means, and function in substantially the same way to accomplish the same results", and are equivalent.

In defendants-appellees' view, this ends the matter. Plaintiffs-appellants fought hard to obtain a jury verdict that mounting a tone bar on a link connected to a key is equivalent to mounting the tone bar directly on an extension of the key, and that limiting the key motion elsewhere than at the key support ledge was equivalent to doing it at the key support ledge; and, having succeeded, they must now suffer the consequences that such findings may have on their case for validity, which findings, in our view,

totally destroy plaintiffs-appellants' hope for validity. Having established that the only distinction upon which validity can rest is "no difference", all of defendants' elaborate allegations of great economies in manufacture, great commercial success, etc., even if true, lose their significance. As far as the claimed invention is concerned, it is virtually the same as Bienengraber, and such advantages or successes as may flow from that structure were in the public domain before Musser. He may have been lucky enough to capitalize on them commercially, but this does not mean that he invented them.

IV. DEFENDANTS-APPELLEES' DETAILED REPLY TO PLAINTIFFS-APPELLANTS' BRIEF

(1) *The Invention*

In their description of the invention, plaintiffs attempt to glorify the invention by reference to the carillon sound and other features such as its simplicity and suitability for mass production in molded plastic, but they fail to mention that the carillon sound feature was old (Bienengraber) or that the alleged simplicity and plastic mass production features are not mentioned in the claim.

When one actually looks at the claim and its prosecution in the Patent Office and attempts to determine what was supposed to have been invented, one finds that Musser laid his hopes for patentability on the fact that his tone bars were mounted directly on a rearward extension of his keys rather than being mounted on a rearwardly extending linkage which is actuated by the keys (Vol. I, p. 74). Such a distinction, in our view, could hardly be called an invention. It is well settled in patent law that merely making a one-piece item out of that which was formerly more than one part, is not inventive where no new function results; *Mostantuno v. Ronconi*, 278 F. Supp. 144, 156 USPQ 629

(D.C. S.D. N.Y. 1968); *Monoplastics, Inc. v. Caldoz, Inc.*, 264 F. Supp. 57, 153 USPQ 328, 331 (D.C. Conn. 1966).

Here no new function resulted. In *Bienengraber*, the player pushed the key and thereby moved the tone bar into playing position. The same takes place in *Musser*. It makes no difference whatsoever to the function of the instrument whether the tone bar is mounted on an integral rearward extension of the key or on a linkage element extending rearwardly of the key.

Plaintiffs' statement of the invention, therefore, is too broad and misses the point. It deals with subject matter which is either in the public domain or not in the claim and in either case not available to plaintiff to support its claim of validity.

(2) *Plaintiffs-Appellees' reliance on commercial success is misplaced*

Plaintiff relies heavily upon commercial success. In the case at bar, however, commercial success as the *Musser* device enjoyed was not proved. The duration of commercial success is relevant, *Ripple Sole Corp. v. Am. Biltrite Rubber Co., Inc.*, 302 F.2d 2, 133 USPQ 355 (C.A. 1, 1962). Thus, commercial success is of little value if, as the Court stated in the *Ripple Sole* case, "the most probable explanation for its commercial success is that its novel appearance made it catch on as a fad or temporary style".

In the case at bar, the *Musser* "Bell Organ" had a novel appearance due primarily to its size. Since it was very close in structure to *Bienengraber*, it can properly be called a miniaturization of *Bienengraber*. Of course, mere miniaturization cannot support patentability, *American Infra-Red Radiant Co., Inc. v. Lambert Industries, Inc.*, 360 F.2d 977, 149 USPQ 722, 723 (C.A. 8, 1966); *Canadian Ingersoll-Rand Co. Ltd. v. Peterson Products of San Mateo*, 223 F. Supp. 803, 139 USPQ 61, 64-65 (D.C. N. Calif. 1963).

The reduction in size, however, could be regarded as comprising a "novel appearance" due to which it "caught on as a fad or temporary style". In any event, it had gone completely off the market long prior to the present controversy.

In addition, the Musser device included a feature not involved in the present litigation, which may have accounted at least in part, for such temporary commercial success as it did enjoy. Thus, the Musser device included "resonating columns" which gave the sound a continuous tone more like the sound of an organ than the rapid percussive sound of the accused devices which is much more like a bicycle bell (see Vol. I, page 40, col. 1, lines 70-75; col. 2, lines 1-15). The "resonating columns" are covered by claims 4, 5, 6, 10, 11, 12 not in issue in this case.

(3) *The Jury's finding of non-obviousness of the accused devices*

The jury did not find that the claims in issue were non-obvious as plaintiffs imply. The jury's finding was directed to a comparison between the accused devices and the prior art, and the jury found the accused devices to be non-obvious in view of the prior art. However, the obviousness or non-obviousness of the accused structures, which include many features not in the patent in suit, is, of course, not relevant to the obviousness of the structure claimed by Musser. We are not here concerned with the patentability of the accused structures, but with the patentability of the structure defined in Musser's claims. Thus, plaintiffs' emphasis on this point is misplaced.

(4) *Plaintiffs' contention that the Court reversed the proper order is not well taken*

Prior to the trial, the parties agreed to trying the infringement issue separately from the validity and, first,

before the trial of the validity issue. The parties recognized that this was a reversal of the normal order, but all concerned were aware of the reasons for it and agreed. Therefore, plaintiffs' objection now to the Court's procedure of deciding infringement first and validity second is not well taken and contrary to plaintiffs' concurrence therein at the trial.

Moreover, plaintiffs' contention that the standard is different depending upon which issue is decided first, is not correct. Ever since the famous "nose of wax" case, it has been settled law that the claims of a patent will be construed in the same manner for validity as for infringement, *White v. Dunbar*, 119 U.S. 47 (1886). It follows, therefore, that if validity is decided first, the standard established for that decision must be employed in the validity issue which follows, as the Trial Court did in the case at bar.

(5) *Plaintiffs' request for a narrow interpretation of the claims so as to preserve their validity fails additionally because, even if narrowly construed, they are invalid*

Plaintiffs wish the claims to be construed so as to be specifically and narrowly limited to the structure in which the tone bars are mounted directly on an integral rearward extension of the key. We think that predicated invention on such a change is ridiculous. Even if it were better to do so it would not be inventive. Not all improvements are patentable. There must be at least an exercise of inventive skill, *Sakranda v. Ag Pro, Inc.*, U.S. , 189 USPQ 449 (1976). In the case at bar, the difference upon which plaintiff predicates invention is merely the change from a multi-part arrangement to a single part element which does exactly the same thing. As such it is not inventive, *Mostantuono v. Ronconi*, supra; *Monoplastics, Inc. v. Caldoz, Inc.*, supra.

(6) *The level of ordinary skill in the art is easily ascertainable from reading the references*

Plaintiffs contend that the level of ordinary skill in the art was not established by the Trial Court in this case prior to the decision of invalidity. Plaintiffs, however, agree that the prior art patents are easily understood by laymen (Vol. II, page 193) (See also page 5 of plaintiffs' brief). Plaintiffs also agreed that there were no relevant facts which the Court could not determine with reference to the documents of record. From this it follows that the level of skill of the artisan is established by reference to the documents, and that the Court was in just as good a position to do so as anyone else.

CONCLUSION

Claim 1 of the Musser patent is invalid for many reasons, but mainly because it is anticipated by Bienengraber in all ways except for differences which are so slight as to have been found to be equivalent by the jury. Plaintiffs' other points are not well taken, but even if true they cannot overcome the fact that there is no inventive distinction between Bienengraber and claim 1 of the patent in suit.

A decision affirming the decision of the Trial Court is therefore respectfully requested.

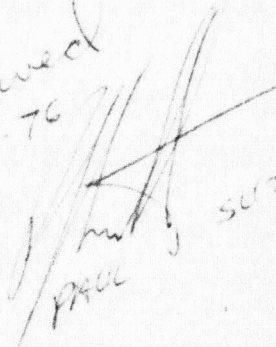
Respectfully submitted,

ROBERT B. RUSSELL
RUSSELL & NIELDS
One Boston Place
Boston, Massachusetts 02108
(617) 227-3835
*Attorneys for the
Defendants-Appellees*

Of Counsel:

ELLAS MESSING, Esq.
HAYS, ST. JOHN, ABRAMSON & HEILBRON
120 Broadway
New York, New York 10005

copy received
6-25-76


PAUL SUTTON